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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,427	12/27/2001	Sang-Ho Choi	P67477US0	1550
43569	7590	08/15/2005	EXAMINER	
MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006			HOM, SHICK C	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,427

Applicant(s)

CHOI ET AL.

Examiner

Shick C. Hom

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1 and 3-4 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

2. Figures 1-2 should be designated by a legend such as -- Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 1 and 3-4 are objected to because of the following informalities: in claim 1 line 6 before the words "and a

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source-PDSN" insert ---a source packet control function (S-PCF) -- in order to provide antecedent basis for "the S-PCF" recited in claim 1 line 21. Claims 3-4 are objected to because they depend from objected claim 1. Appropriate correction is required.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1 and 3-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-4 of Application No. 10/026,620 and Choi et al. (2002/0048266). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

For claims 1, 3-4, the claims 1, 3-4 of copending application 10/026,620 discloses a method for performing an intra-packet data service node (PDSN) soft handoff, comprising the steps of: (a) setting up a channel passing through a target base station controller (T-BSC), a source base station controller (S-BSC) and a PDSN by establishing a direct channel link between the S-BSC and the T-BSC in an active packet session

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mode; (b) performing a handoff between the S-BSC, the T-BSC and a mobile station (MS); (c) transmitting or receiving user packet data exchanged between the MS, and the S-BSC and the T-BSC to or from the PDSN through the established channel link; and (d) sending or receiving user packet data exchanged between the MS and the T-BSC to or from the PDSN through the established channel link when the handoff is completed (see claim 1);

wherein, in the step (c), one of packet data transmitted from the MS to the PDSN through the S-BSC and the T-BSC is selected and transmitted to a wireless packet data service network (see claim 3); and

wherein the channel link established between the S-BSC and the T-BSC is an A3 channel link set up by transmitting an A7 Handoff Request message from the S-BSC to the T-BSC (see claim 4).

For claims 1, 3-4, claims 1, 3-4 of copending application number 10/026,620 disclose all the subject matter of the claimed invention with the exception of the packet data service node (PDSN) being the source-PDSN (S-PDSN) (claims 1, 3-4 of the copending application 10/026,620 do not recite the PDSN being the source); and the steps of (e) establishing a channel link between the T-BSC, a target packet control function (T-PCF) and a target-PDSN (T-PDSN) in a dormant packet session mode; (f) releasing the channel link set up between the S-BSC, the S-PCF and the S-PDSN; (g) releasing the channel link established between the S-BSC and the T-BSC, which is established in the step (a); and (h) performing a point-to-point (PPP) establishing process and a mobile Internet protocol (MIP) registering process between the MS and the T-PDSN as in claim 1. Claim 1 of the application recite both transmitting or receiving packet data to or from the PDSN clearly indicate that it would be obvious to the person of ordinary skill in the art at the time of the invention to replace the PDSN unit as taught by the copending application with the S-PDSN. The motivation for providing the S-PDSN in the method of claim 1 of copending application 10/026,620 being that it provide the source of packet data, i.e. transmits packet data to the mobile station. Further, Choi et al. from the same or similar fields of endeavor teach that it is known to provide the steps of (e) establishing a channel link between the T-BSC, a target packet control function (T-PCF) and a target-PDSN (T-PDSN) in a dormant packet session mode; (f) releasing the channel link set up between the S-BSC, the S-PCF and the S-PDSN; (g) releasing the channel link established

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between the S-BSC and the T-BSC, which is established in the step (a); and (h) performing a point-to-point (PPP) establishing process and a mobile Internet protocol (MIP) registering process between the MS and the T-PDSN (see paragraph 0038 which recite establishing channel link to the target base station to support packet dormant handoff of the mobile station; paragraph 0039 which recite source base station releasing the call source of the source base station; paragraph 0040 which recite releasing the source base station; and paragraph 0031 which recite the use of point-to-point protocol ppp between the mobile station and the PDSN). Thus, it would have been obvious to the person having ordinary skill in the art at the time the invention was made to provide the steps of (e) establishing a channel link between the T-BSC, a target packet control function (T-PCF) and a target-PDSN (T-PDSN) in a dormant packet session mode; (f) releasing the channel link set up between the S-BSC, the S-PCF and the S-PDSN; (g) releasing the channel link established between the S-BSC and the T-BSC, which is established in the step (a); and (h) performing a point-to-point (PPP) establishing process and a mobile Internet protocol (MIP) registering process between the MS and the T-PDSN as taught by Choi et al. in the soft handoff method of copending application number 10/026,620. The steps of (e) establishing a channel link between the T-BSC, a target packet control function (T-PCF) and a target-PDSN (T-PDSN) in a dormant packet session mode; (f) releasing the channel link set up between the S-BSC, the S-PCF and the S-PDSN; (g) releasing the channel link established between the S-BSC and the T-BSC, which is established in the step (a); and (h) performing a point-to-point (PPP) establishing process and a mobile Internet protocol (MIP) registering process between the MS and the T-PDSN can be implemented by including the soft handoff technique of Choi et al. to the handoff method of copending application number 10/026,620. The motivation for using soft handoff technique as taught by Choi et al. in the handoff of copending application number 10/026,620 being that it provides more efficiency for the system since the system can maintain previous communication channel between mobile stations while supporting a new channel during handoff of base stations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
Eyuboglu et al. radio network control.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick C. Hom whose telephone number is 571-272-3173. The examiner can normally be reached on Monday to Friday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SH



D. A. T. N.
PRIMARY EXAMINER